

REMARKS**Status of the claims:**

With the above amendments, claims 1, 2, 6, 7, 9, 11, 12, 18, and 19 have been amended and claims 1-20 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Reconsideration is respectfully requested in light of the following remarks.

Examiner Interview

Applicants and Applicants' representative would like to thank the Examiner and her supervisor for making themselves available to conduct an Interview on July 12, 2006. The gist of the interview was substantially as appears in the Examiner's Interview Summary form.

Rejections under 35 U.S.C. §112, first paragraph

Claim 2 is rejected under 35 U.S.C. §112, first paragraph as allegedly not being enabled.

Applicants traverse.

Applicants submit that one could make and use the invention as claimed in claim 2 without undue experimentation by following the teachings of the written description. In particular, Applicants direct the Examiner's attention to, for example, page 10, lines 18-23 wherein it is described how one can create a vendor. As described in this section, one means of creating a vendor is by supplementing an existing vendor with additional equipment necessary to manufacture a part according to a recipe (for example, when the

vendor does not have the requisite equipment necessary to make the part according to a recipe). Applicants respectfully submit that one of skill in the art would know how to supplement the existing vendor with additional equipment so that one could create a vendor without undue experimentation. Accordingly, the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. §112, second paragraph

Claims 6, 7, 9, 11, 12, 18, and 19 are rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite.

Regarding claims 6, 7, 9, 11, and 12, the Examiner asserts that the term “effective” renders these claims indefinite. Applicants have removed the term “effective” from these claims. Accordingly, Applicants believe that the rejection is moot. Withdrawal of the rejection is warranted and respectfully requested.

Regarding claims 18 and 19, the Examiner asserts that there is insufficient antecedent basis for the terms “said executing said recipe” in claims 18 and 19. Applicants have amended claims 18 and 19 to recite “executing said recipe”. Applicants believe that with this change that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. § 101

Claim 2 is rejected under 35 USC §101 as allegedly lacking utility. The Examiner asserts that claim 2 as it currently stands has no concrete or tangible result. Applicants respectfully direct the Examiner's attention to MPEP §2107 which states:

A rejection based on lack of utility should not be maintained if an asserted utility for the claimed invention would be considered specific, substantial, and credible by a person of ordinary skill in the art in view of all evidence of record.

Applicants respectfully submit that claim 2 has a specific, substantial and credible utility that would be readily understood by one of ordinary skill in the art in view of all the evidence of record. Applicants respectfully direct the Examiner's attention to page 10, lines 18-23 wherein it is described how one can create a vendor. A vendor, for example, can be created when one supplements an existing vendor (that may not have had the requisite equipment to manufacture a part) with additional equipment necessary to manufacture a part according to a recipe. This result is specific, substantial, and credible. It is not an abstract concept, but rather, it is both concrete and tangible. For these reasons, Applicants submit that the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 1-5 and 9-20 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Thackston '513 (US Patent No. 6,295,513). Applicants traverse.

Applicants, in the last response filed December 23, 2005, asserted that Thackston '513 could not anticipate the present invention because Thackston '513 failed to disclose all of the elements of the presently claimed invention. In particular, Applicants asserted

that Thackston '513 failed to disclose the element "identifying an optimal machine and tooling combination for producing said part according to said recipe" as appears in claim 1. The Examiner, in the Office Action of March 13, 2006 fails to address where in Thackston '513 this element is disclosed. As a matter of fact, the Examiner on page 6, lines 22-23 of the Office Action acknowledges regarding "identifying an optimal machine and tooling combination for producing said part according to said recipe":

However, Thackston does not specifically disclose the identifying of an "optimal" combination, for this reason the patented invention to Kakazu et al. (hereinafter "Kakazu") is relied upon.

Applicants agree with the Examiner regarding this statement. Further, Applicants respectfully point out that if the above statement is true, then as a **matter of law**, Thackston '513 cannot anticipate the instant invention because Thackston '513 fails to disclose the elements of the instantly claimed invention.

Moreover, Applicants assert that not only does Thackston '513 fail to disclose "identifying an optimal machine and tooling combination for producing said part according to said recipe", Thackston '513 also fails to suggest this element. Accordingly, Thackston '513 cannot anticipate the presently claimed invention. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 6-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thackston '513.

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thackston '513 in view of Kakazu '199 (US Patent No. 5,388,199).

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kakazu '199 in view of Thackston '513.

Applicants traverse.

Removal of the Rejection of claims 6-8 over Thackston '513

To establish a proper *prima facie* case of obviousness, three basic criteria must be met.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142.

Applicants submit that the Examiner has failed to show any of these criteria. For example, the Examiner has failed to show criteria 3) that the prior art reference (or references when combined) teach or suggest all the claim limitations.

In the response that was filed December 23, 2005, Applicants pointed out that Thackston '513 fails to disclose the element "identifying an optimal machine and tooling combination for producing said part according to said recipe" as claimed in claim 1. Claims 6-8 are ultimately dependent from claim 1, and thus, claims 6-8 have all of the elements present in claim 1 present in them including the element "identifying an optimal machine and tooling combination for producing said part according to said recipe".

The Examiner on page 6, lines 22-23 of the Office Action acknowledges that Thackston '513 fails to disclose the element "identifying an optimal machine and tooling combination for producing said part according to said recipe". In this regard, the Examiner states:

However, Thackston does not specifically disclose the identifying of an "optimal" combination, for this reason the patented invention to Kakazu et al. (hereinafter "Kakazu") is relied upon.

Applicants agree with the Examiner regarding this statement. Further, Applicants respectfully point out that if the above statement is true, then as a **matter of law**, Thackston '513 cannot render obvious the instant invention because Thackston '513 fails to disclose the elements of the instantly claimed invention. Accordingly, the Examiner has failed to show the third element to make a proper *prima facie* rejection (*i.e.*, that the reference or references when combined teaches or suggests all of the claim limitations). For this reason alone, a proper *prima facie* case of obvious has not been presented.

Moreover, Applicants submit that Thackston '513 provides no motivation or suggestion for the element "identifying an optimal machine and tooling combination for producing said part according to said recipe".

In this regard, Applicants respectfully submit that Thackston '513 actually teaches away from "identifying an optimal machine and tooling combination". The purpose of Thackston '513 is to identify fabricators who look at audio, visual, and graphics through their virtual CAD capability. The fabricators (who possess the machines and tooling apparatus) determine if they can manufacture the part in accordance with the associated specifications (*i.e.*, whether they have the ability to manufacture the part according to the tools that they have), standards and other design specific documents on the network.

Applicants respectfully point out that the ability to manufacture a part is not the same as “identifying an optimal machine and tooling combination for producing said part according to said recipe”. In one case, one is identifying the optimal way to make a part (as claimed) whereas in Thackston ‘513, the fabricators determine if they have the minimal tooling and machine requirements to make the part and then bid on the part based upon the minimal requirements. In other words, in the case of Thackston ‘513, one is not concerned with optimizing the machine and tooling combination to make the part but rather is only concerned with an ability to make a part without having the machine and tooling combination optimized. See column 5, line 61 to column 6, line 9 and column 3, lines 3-6 in Thackston ‘513. For this reason also, Applicants respectfully submit that Thackston ‘513 cannot render the present invention *prima facie* obvious. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Removal of the Rejection of claims 1-20 over Thackston ‘513 in view of Kakazu ‘199 and over Kakazu ‘199 in view of Thackston ‘513

Applicants submit that the Examiner has also failed to establish a proper *prima facie* case of obviousness over the combination of Thackston ‘513 and Kakazu ‘199.

To establish a proper *prima facie* case of obviousness, three basic criteria must be met.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.

3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142.

Applicants submit that the Examiner has failed to show any of these criteria. For example, the Examiner has failed to show criteria 1) that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

In the office action of March 13, 2006, the Examiner writes:

With regard to the newly added limitation of claim 1 wherein the identification of an optimal machine and tooling combination for producing a part is claimed, Thackston teaches the selection of fabricators for manufacturing part design through the identification of qualified fabricators based on information stored in a global database, see abstract and col. 5 ll. 30-54. However, Thackston does not specifically disclose the identifying of an optimal combination, for this reason the patented invention to Kakazu et al. (hereinafter "Kakazu") is relied upon. Kakazu discloses a machine tool determining module that chooses the optimal machine tool from a machine tool registry or master file.

In the above passage, the Examiner infers that it would be obvious to combine the teachings of Thackston '531 with Kakazu '199. Applicants disagree. Applicants respectfully submit that the teachings of Thackston '531 cannot be combined with the teachings of Kakazu '199 because if one were to use the teachings of Kakazu '199 it would destroy the purpose of Thackston '531.

Applicants respectfully direct the Examiner's attention to *In re Gordon* which holds that if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or

motivation to make the proposed modification.” See *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). Also see MPEP § 2143.01.

In the instant case, using the element “a machine tool determining module that chooses the optimal machine tool from a machine tool registry or master file” that is used by the Examiner from Kakazu ‘199 destroys the purpose of Thackston ‘531. The purpose of Thackston ‘531 is to have the fabricators determine if they can make a part based on their fabricator capability. The process proceeds by conducting a virtual bidding process whereby electronic representations of three dimensional model and specification data are provided by a central server. See the abstract, column 1, lines 19-29, column 5, line 61 to column 6, line 9, and column 3, lines 3-6 in Thackston ‘531. In other words, the purpose of Thackston ‘531 is to find a fabricator who has the ability to make a part using minimal requirements to make the part wherein the fabricator is selected based on bids. The fabricators are the ones who input data regarding their capabilities into the database. See column 1, lines 24-26. The fabricators are able to view the parts on the virtual integrated computer-based system and determine if they have the minimal machining requirements necessary to make the part.

If one were to use the Examiner’s asserted teaching of Kakazu ‘199 for its “machine tool determining module that chooses the optimal machine tool from a machine tool registry or master file”, the fabricators would no longer be the ones who determine if they can make a part based on the machines and tooling apparatus that they have in their possession. In other words, the purpose as set out in Thackston ‘531 would be destroyed.

Following the holding in *Gordon*, Applicants submit that as a matter of law, a proper *prima facie* case has not been made with respect to the rejection over Thackston

'531 in view of Kakazu '199. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Likewise, even if Kakazu '199 is used as the primary reference, a proper *prima facie* obviousness rejection has not been presented. Using Kakazu '199 for its "machine tool determining module that chooses the optimal machine tool from a machine tool registry or master file" would destroy the purpose of Thackston '531 as described above. Accordingly, the rejection over Kakazu '199 in view of Thackston '513 is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

CONCLUSION

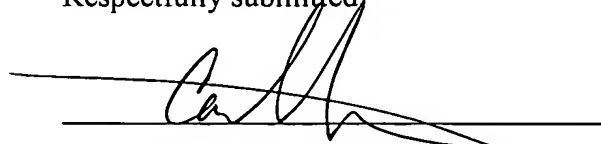
With the above amendments and remarks, Applicants believe that all objections and/or rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. A passage of the instant invention to allowance is earnestly solicited.

Applicants respectfully petition for two months extension of time. Applicants believe that no additional fees are necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 16-1435.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (336) 607-7486 to discuss any issues.

Respectfully submitted,

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